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09/504,236	02/15/2000	Swain W. Porter	112076-138321	7611

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EXAMINER

SHINGLES, KRISTIE D

ART UNIT PAPER NUMBER

2141

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/504,236	Applicant(s) PORTER, SWAIN W.	
	Examiner Kristie Shingles	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12, 13, 15-20, 24, 26, 28, 29, 31-38, 41-43, 45, 46 and 48-71 is/are rejected.
- 7) ☒ Claim(s) 14, 27 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-6, 12-20, 24, 26-29, 31-38, 41-46 and 48-71 are pending.

RESPONSE TO AMENDMENTS

1. No claims have been amended. Claims 7-11, 21-23, 25, 30, 39, 40 and 47 are cancelled.

RESPONSE TO ARGUMENTS

2. Applicant's arguments, see Remarks pages 16-19, filed 7/3/2006, with respect to the rejections of claims 1, 24, 28, 33, 35, 41, 45, 50, 52, 56, 59, 62 and 67 under 35 U.S.C. 102(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of *Pennell et al* (US 6,874,023) in view of *Winblad* (US 6,205,330) in further view of *Waskiewicz* (US 5,822,526).

ALLOWABLE SUBJECT MATTER

3. **Claims 14, 27 and 44** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

- **Claim 14:** The method of claim 12, wherein said notifications are performed subsequently in batch after said first and second email addresses were provided to said user for use to register the user with the first and the second web sites.

- **Claims 27 and 44** contain limitations that are substantially similar to claim 14.

4. The prior art of record teaches generating multiple alias email addresses for registered users wherein the users are able to dictate how the alias address are used (i.e., in correspondence for particular websites). However the prior art fails to explicitly teach the specific features of batch-notification which allows for notifications to the email provider to be sent in batches pertaining to the employment of the respective email addresses at respective websites.

CLAIM REJECTIONS - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-6, 15, 16, 20, 28, 29, 41, 45, 46, 56, 57, 59, 60, 62, 64-67 and 71** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) in further view of *Waskiewicz* (US 5,822,526).

a. **Per claim 1**, *Pennell et al* teach a method comprising:

- a user computer providing a first email address received from an email service provider for use to register a user of the user computer with a first web site (col.1 lines 53-62); and
- the user computer providing a second email address received from the email service provider, separate and distinct from the first email address, for use to register said user with a second web site (col.1 lines 12-15 and 56-61, col.3 lines 24-34).

Although *Pennell et al* teach an email management service that generates a new email address whenever needed or requested by the user (col.3 lines 1-12 and 35-42, col.4 lines 15-17), *Pennell et al* fail to explicitly teach wherein the first and second email addresses were simultaneously provided to the user computer by the email service provider in advance of providing the first and second email addresses to the first and second web sites by the user computer. However, *Winbladh* teaches that upon successfully obtaining an email account, a user is sent correspondence including the registered email address and alias addresses for the registered user (col.4 lines 54-57, col.8 lines 46-50). Furthermore, *Waskiewicz* teaches that when a new mailbox is created for a user, a proxy address is also created, wherein there may exist multiple proxy addresses for one email address (col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al* and *Winbladh* with *Waskiewicz* for the purpose of generating first and second (multiple) email addresses to registered users, in order to provide the users with additional email addresses usable for communicating with particular websites or other users from aliased identities which ensures the user's privacy and minimizes unsolicited email communications with the user.

b. **Claims 28, 41, 45, 56, 59, 62 and 67** contain limitations that are substantially equivalent to claim 1 and are therefore rejected under the same basis.

c. **Per claim 2**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Waskiewicz* further teaches wherein the first email address comprises a first user identifier, and the second email address comprises a second user identifier, separate and distinct

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from said first user identifier (col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44; *Winbladh*: col.4 lines 54-57, col.8 lines 46-50).

d. **Claim 4** is substantially similar to claim 2 and is therefore rejected under the same basis.

e. **Per claim 3**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Pennell et al* further teach wherein the first email address comprises an address of the email service provider, and the second email address comprises the address of the same email service provider (col.3 lines 1-12 and 35-42; *Winbladh*: col.4 lines 54-57, col.8 lines 46-50).

f. **Per claim 5**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Winbladh* further teaches wherein said providing of the first and second email addresses by the user computer comprises selecting by said first and second email address from a plurality of distinct email addresses simultaneously provided by said email service provider to said user computer (col.4 lines 54-57, col.8 lines 46-50; *Waskiewicz*: col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44).

g. **Claim 29** is substantially similar to claim 5 and is therefore rejected under the same basis.

h. **Per claim 6**, *Winbladh* teach the method of claim 5, wherein the method further comprises the user computer obtaining the distinct email addresses from the email service provider in advance of the selection (col.4 lines 54-57, col.8 lines 46-50; *Waskiewicz*: col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44).

i. **Per claim 15**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Pennell et al* further teach wherein the method further comprises: receiving emails

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addresses to said first and second email; organizing said received emails based at least in part on whether the emails are addressed to the first of the second email address (col.4 lines 15-43).

j. **Per claim 16**, *Pennell et al* teach the method of claim 15, wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (Figure 6, col.3 lines 53-65, col.4 lines 35-43).

k. **Claims 64, 65, 69 and 70** are substantially similar to claims 15 and 16 and are therefore rejected under the same basis.

l. **Per claim 20**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 1, *Pennell et al* further teach wherein the web site is a content provider, a service provider and an access provider (col.1 lines 17-31).

m. **Per claim 46**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the apparatus of claim 45, *Winbladh* further teach wherein the programming instructions (when executed) enable the apparatus to provide a plurality of distinct email addresses to the electronic device used by the user in advance of the first and second email addresses' initial selection for usage, for the electronic device to select said first and second separate and distinct email addresses (col.4 lines 54-57, col.8 lines 46-50).

n. **Claims 57 and 60** are substantially similar to claims 5 and 46 and are therefore rejected under the same basis.

o. **Per claim 66**, *Pennell et al* and *Winbladh* with *Waskiewicz* teach the method of claim 62, *Waskiewicz* further teach the method further comprising: generating and sending a request to the email service provider to return a set of email addresses including a plurality of

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distinct email addresses (col.5 lines 4-23, col.6 lines 20-44; *Winbladh*: col.4 lines 54-57, col.8 lines 46-50).

p. **Claim 71** is substantially similar to claim 66 and is therefore rejected under the same basis.

7. **Claims 13, 24, 26, 31, 32, 42, 43, 48, 49, 58 and 61** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) and *Waskiewicz* (US 5,822,526) in further view of *Bunney* (US 6,487,584).

q. **Per claim 24, *Pennell et al* teach a method comprising:**

- an electronic device requesting and receiving for a user, a first email address from an email service provider at a first point in time subsequent to the user subscribing for email service with the email service provider (col.1 lines 53-62);
- the electronic device employing the received first email address to facilitate communication between the user and a first communication partner or group of communication partners (col.1 lines 12-15 and 56-61, col.3 lines 24-34);
- the electronic device requesting and receiving for the user, a second email address, separate and distinct from said first email address, from the email service provider at a second point in time subsequent to the user subscribing for email service with the email service provider, the second point in time being a later point in time than the first point in time (col.1 lines 53-62, col.3 lines 1-12); and
- the electronic device employing the received second email address to facilitate communication between the user and a second communication partner or group of communication partners (col.3 lines 13-65).

Winbladh teaches that upon successfully obtaining an email account, a user is sent correspondence including the registered email address and alias addresses for the registered user (col.4 lines 54-57, col.8 lines 46-50). Furthermore, *Waskiewicz* teaches that when a new mailbox is created for a user, a proxy address is also created, wherein there may exist multiple proxy

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addresses for one email address (col.3 lines 4-20, col.5 lines 4-23, col.6 lines 20-44). Yet *Pennell et al*, *Winbladh* and *Waskiewicz* fail to explicitly teach the electronic device, prior to the first communication partner or group of communication partners initiating a communication with the user, notifying the email service provider of said employment of the first email address to facilitate communication with the first communication partner or group of communication partners and the electronic device, prior to the second communication partner or group of communication partners initiating a communication with the user, notifying the email service provider of said employment of the second email address to facilitate communication with the second communication partner or group of communication partners.

However, *Bunney* teaches the server keeping a database of user profile information wherein before the user establishes communication using an alias address, the database is checked to determine if that particular alias exists for the user—it also checks whether the user switches to a different alias (col.6 lines 30-52, col.7 lines 31-37, col.8 lines 25-30, col.8 line 45-col.8 line 46, col.10 lines 6-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al*, *Winbladh* and *Waskiewicz* with *Bunney* for the system to provide means for determining which email address (or alias) is currently being used by the user and checking to assure the email address (or alias) is valid and corresponds to the respective user, in order to track users' session activity and thereby track which users are logged into the system.

r. **Claims 13, 26, 31, 32, 42, 43, 48, 49, 58 and 61** are substantially similar to claim 24 and are therefore rejected under the same basis.

8. Claims 12, 17-19, 33-38, 50-55, 63 and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Pennell et al* (US 6,874,023) in view of *Winbladh* (US 6,205,330) and *Waskiewicz* (US 5,822,526) in further view of *Gabber et al* (US 6,591,291).

s. **Per claim 33**, *Pennell et al*, *Winbladh* and *Waskiewicz* teach a method comprising: an email service provider receiving emails addressed to a first and second email address of a user, the first and second email addresses having been provided by the email service provider to an electronic device of the user for the electronic device to facilitate respective communication between the user and a first and a second intended communication partner (*Pennell et al*: col.3 lines 1-65; *Winbladh*: col.4 lines 54-57, col.8 lines 46-50; *Waskiewicz*: col.5 lines 4-23, col.6 lines 20-44).

Pennell et al further teach the email server provider organizing the received emails based on the distinct email addresses of users and allowing for the user to designate which are wanted or unwanted (Figure 6, col.3 lines 53-65, col.4 lines 35-43); yet *Pennell et al* and *Winbladh* with *Waskiewicz* fail to explicitly teach the email server provider organizing said received emails based at least in part on said first and second email addresses of the user, and respective intended versus unintended communication partners of said first and second email addresses of the user. However *Gabber et al* teach organizing and filtering of reply emails based the alias source address, wherein the alias source address depends on the destination address in order to identify which alias addresses are reject alias source addresses—if the reply email contains a reject alias source address then the reply message is deleted (Abstract, col.3 lines 20-44, col.8 lines 5-18 and 27-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* for the purpose of organizing email messages according to the user's different email addresses and presenting the email messages of interest to the user, wherein the user can bypass reading messages from parties of no interest. This also provides users an effective way to determine where junk email purveyors obtained the user's alias source address.

t. **Claims 17, 35, 36, 50, 52, 53 and 69** contain limitations that are substantially equivalent to claim 33 are therefore rejected under the same basis.

u. **Per claim 34**, *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* teach the method of claim 33, *Pennell et al* wherein said organizing of said received emails is at least further based on whether said received emails addressed to said first or second email address were sent respectively by said first or second web site or not (Figure 6, col.3 lines 53-65, col.4 lines 35-43; *Gabber et al*: col.8 lines 56-66).

v. **Claim 51 and 70** are substantially equivalent to claim 34 and are therefore rejected under the same basis.

w. **Per claim 37**, *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* teach the method of claim 36, *Gabber et al* further teach wherein said deletion is performed in response to user instruction (col.8 lines 35-37).

x. **Claims 18 and 54** are substantially similar to claim 37 and are therefore rejected under the same basis.

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y. **Per claim 38**, *Gabber et al* teach the method of claim 37, wherein the method further comprises providing the user with an end user interface feature to provide said deletion instruction with a single press of a key or control button (col.3 lines 26-34, col.8 lines 56-66).

z. **Claims 19 and 55** are substantially similar to claim 38 and are therefore rejected under the same basis.

aa. **Per claim 63**, *Pennell et al*, *Winbladh* and *Waskiewicz* with *Gabber et al* teach the method of claim 62, *Gabber et al* further teach the method further comprising: sending information to the email service provider relating the first email address to the first intended communication partner or partners and the second email address to the second intended communication partner or partners (col.3 lines 35-41, col.8 lines 27-50).

bb. **Claims 12 and 68** are substantially similar to claim 63 and are therefore rejected under the same basis.

CONCLUSION

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Montville et al (6,356,937), Nestoriak III et al (6,353,852), Mousseau (2001/0009015), Millard (6,643,685), Arnold et al (6,965,918), Fuisz (6,389,455).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristie Shingles whose telephone number is 571-272-3888. The examiner can normally be reached on Monday-Friday 8:30-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kristie Shingles
Examiner
Art Unit 2141

kds


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SUPERVISORY PATENT EXAMINER